



Application No. 09/919,958
Art Unit 2137

Docket No. 35997-215058
Customer No. 26694

REMARKS

Claims 1-6, 8-18 and 20-25 remain pending in the present application. Claims 1, 11, 15, 20 and 25 are independent claims. Applicant requests reconsideration and allowance in view of the following remarks.

Advisory Action

In the Advisory Action of August 8, 2006, the Advisory Action states that Applicant's arguments have attacked the references without considering the combination as a whole. Applicant respectfully disagrees. However, Applicant's arguments are re-phrased below.

Rejection under 35 U.S.C. § 103(a) based on Fischer, Goodman, Menezes and Nakamura

On pages 2-7, the Action rejects claims 1-6, 8-18 and 20-25 under 35 U.S.C. 103(a) as allegedly being unpatentable over Fischer (U.S. Patent No. 5,001,752) in view of Goodman (U.S. Patent No. 5,001,752), Menzes (Handbook of Applied Cryptography), and Nakamura (U.S. Patent No. 6,457,126). Applicant respectfully traverses this rejection.

For at least the following reasons, Applicant disagrees with the assertions made in the Office Action alleging that the cited references in combination render claim 1 obvious under 35 U.S.C. § 103(a). Further, Applicant asserts that the Action fails to present a *prima facie* case of obviousness.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP 706.02(j) (emphasis added).

As an initial matter, the Action fails to identify a legally cognizable suggestion for combining Fischer, Goodman, Menezes and/or Nakamura. Secondly, even if the cited references were combined, the combination does not result in the claimed invention.

Turning first to the suggestion to combine the references, the Office action states: (1) it would have been obvious to a person of ordinary skill in the art to use Goodman's different modes in the time stamping system of Fischer to allow the checking of processes being performed by the processor; (2) that it would have been obvious to a person of ordinary skill in the art to use Menezes' idea of session keys to prevent the key from being used again after time stamping operations have been performed to create independence across communications sessions and applications; and (3) that it would have been obvious to a person of ordinary skill in the art to use the same key in both modes of the modified Fischer, Goodman and Menezes system to test the secure memory. However, as a matter of law and fact, these are not proper suggestions for combining Fischer, Goodman, Menezes and/or Nakamura.

As a matter of law, in *In re Rouffet*, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) the Federal Circuit explained: To reject claims in an application under section 103, an examiner must show an un rebutted prima facie case of obviousness. In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. *Id.* at 1455 (citations omitted).

In the *Rouffet* case, the Examiner had rejected the pending claims on a combination of references. The Board sustained the Examiner. However, the Federal Circuit reversed the Board's decision and ruled that the Examiner's rejections were legally impermissible because they failed to demonstrate a suggestion for combining the references in the manner proposed by the Examiner. As explained by the Federal Circuit:

As this court has stated, "virtually all [inventions] are combinations of old elements." Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue.

Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. *Id.* at 1457-58. (citations omitted).

These principles have not been followed in rejecting claim 1. Merely stating an advantage or possible advantage of combining references, as was done to reject claim 1, is not the same as "show[ing] a motivation to combine the references."

On the contrary, in order to establish a prima facie case of obviousness, there must be actual evidence of a suggestion to modify a prior art reference or to combine prior art references, and the suggestion to combine or modify the prior art must be clear and particular. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In order to establish a prima facie case of unpatentability, particular factual findings demonstrating the suggestion to combine must be made. See, for example, *Ecolochem Inc. v. Southern California Edison*, 56 U.S.P.Q.2d 1065, 1072-73 (Fed. Cir. 2000), *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617-1618 (Fed. Cir. 1999).

Applicant respectfully submits that the "suggestions" in support of the rejection of claim 1 amount to nothing more than speculative statements that, given the alleged presence of the claim elements in the prior art and an advantage that combining these elements would allegedly achieve, a person skilled in the art would have found it obvious to combine the references to create the claimed invention. Applicant respectfully submits that the problem with this approach is that it effectively eliminates the requirement of identifying a suggestion for combining references from the obviousness analysis.

The inherent flaw in the analysis employed in rejecting claim 1 may be seen by viewing the alleged "suggestions" the Action identifies in support of the rejection. As noted above, in rejecting claim 1, the Action states: it would have been obvious to a person of ordinary skill in the art to use Goodman's different modes in the time stamping system of Fischer to allow the

checking of processes being performed by the processor. The first part of the statement simply states what the proposed modification of the primary reference is to be; in this case modifying Fischer to include a work mode, a test mode and a pseudo-test mode from Goodman. This first part of the statement, thus, describes the proposed modification, but offers no explanation of a motivation for making that modification. The second part of the statement, namely, "to allow the checking of processes being performed by the processor," must, then be the alleged "motivation" for modifying Fischer.

However, while it is true that one possible advantage of a separate encryption and test mode is to allow the checking of processes being performed by the processor, that is not a suggestion in and of itself for using a separate encryption and test mode in Fischer. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992). Here, the Action does not identify any evidence in the prior art indicating or in any way suggesting the desirability of the proposed modification. It only identifies an old element that has an inherent property. Indeed, the Action's conclusory statement amounts to nothing more than stating "A person of ordinary skill in the art would be motivated to modify Fischer to include a second work/test mode because they would want to gain a benefit from having a work/test mode. In other words, the Examiner is effectively saying that the motivation of adding a work/test mode to Fischer is to have the inherent benefit of adding a work/test mode. Such circular reasoning (i.e., add "X" to have "X") cannot be a legally proper tool for identifying a suggestion for combining references. If it were, no combination of old elements would ever be patentable since one can always nakedly state, a person would be motivated to add old element X from one reference to another reference because adding element X offers an advantage (again, if adding "X" had no advantage, who would ever claim it?). Simply put, there is always an advantage to combining old elements that can be identified through hindsight once that combination is known.

Similarly, the "motivation" given to combine the single-use session keys of Menezes with Fischer and Goodman is to prevent a key from being used again after time stamping operations have been performed to create independence across communication sessions and applications. However, there is no suggestion in Fischer or Goodman of the desirability of such

a modification. Fischer reuses the private key in its time stamping functions, and makes no suggestions otherwise.

Similarly, the “motivation” given to use the key allegedly used in two modes of Nakamura with Fischer, Goodman, and Menezes is to test the secure memory. However, although the combination of references has a test mode, there is no suggestion that it would be desirable to use a single key in both an encryption/test mode and a time stamping mode.

It should be quite clear from the above that merely identifying an advantage for adding an old element to a combination of elements is not a proper suggestion for making that combination. The MPEP § 2144 states that “the strongest rationale for combining references is a recognition... in the prior art or... based on established scientific principles or legal precedent, that some advantage would have been produced by their combination.” The MPEP cites *In re Sernaker*, 702 F.2d 989, 994-95 (Fed. Cir. 1983) to support this proposition.

Looking at the *Sernaker* case, we see that the Federal Circuit states: “The lesson of this case appears to be that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.” *Sernaker*, 702 F.2d at 995-96. Notice that this statement does not state that it is obvious to combine references simply because there is an advantage to doing so. On the contrary, it carefully states that there can be no obviousness ruling unless something in the art suggests an advantage to combining the references. The advantage itself is not the suggestion, but rather the Court makes it clear that something else suggests the advantage.

The MPEP quote noted above is similar. This, of course, does not state that the strongest rationale for combining references is the mere presence of an advantage to doing so. Instead, as in *Sernaker*, the strongest rationale is a recognition (i.e., a suggestion) in the art that an advantage will result.

Turning back to the rejections at issue, rather than identifying something in the art that suggests an advantage to making the combination, the Action just looks for the advantage itself and mislabels that advantage as “suggestion.” As explained above, this is a literal elimination of the suggestion requirement. Since there is always an advantage to a claimed element (or why would you claim it?), the Action’s misplaced view of an advantage as the suggestion inherently renders all combinations of old elements unpatentable precisely because it eliminates the

suggestion requirement from the analysis. Clearly, neither the MPEP section noted above nor the *Sernaker* case upon which that MPEP section rests for authority stands for the proposition that an advantage of an element is a suggestion in and of itself for including that element in a combination.

In view of the foregoing, Applicant respectfully submits that the rejection under 35 U.S.C. § 103 of claim 1 must be withdrawn because it fails to identify a legally proper suggestion for combining the prior art references in the manner proposed by the Office action. In other words, the Office has failed to establish a prima facie case of obviousness under 35 U.S.C. § 103. On this basis alone, the rejections of claim 1 and all claims depending therefrom must be withdrawn.

Further, regarding claim 1, the prior art references when combined fail to teach or suggest all the claim limitations of the claim. To summarize Applicant's previous arguments in the first Request for Reconsideration, Fischer fails to teach a system having two separate modes (a first mode for encryption operations and for test operations and a second mode for timestamping operations), and fails to teach using a secure encryption key in the first mode for encryption and test operations and using the secure encryption key in the second mode for timestamping operations. By extension, Fischer fails to teach wherein once the processor performs a function with the secure encryption key in the second mode, it is precluded from performing further functions in the first mode with the same secure encryption key.

Goodman teaches a work mode and a test mode. However, in the two modes taught by Goodman, the encryption processor uses a private test key in the test mode, and a separate secure electronic key in the work mode. Thus, Goodman teaches using separate keys in separate respective "modes". The combination of Fischer and Goodman therefore fails to teach both using a secure encryption key in the first mode for encryption and test operations and using the secure encryption key in the second mode for timestamping operations, and wherein once the processor performs a function with the secure encryption key in the second mode, it is precluded from performing further functions in the first mode with the same secure encryption key.

Menezes fails to teach using a secure encryption key in a first mode for encryption and test operations and using the secure encryption key in a second mode for timestamping

operations. The combination of Menezes with Fischer and Goodman, fails to teach or suggest using a secure encryption key in a first mode for encryption and test operations and using the secure encryption key in a second mode for time stamping operations (i.e. using the same key for encryption/test modes and for time stamping), as the Action concedes.

Nakamura teaches using two keys (e.g. data key K1 and system key K2) in one of the claimed modes. Nakamura discloses an encryption/decryption operation and test operations. Nakamura does not teach or discuss a second timestamping mode. While Nakamura may teach "multiple modes", Nakamura does not teach using a secure encryption key in a first mode for encryption and test operations and using the secure encryption key in a second mode for time stamping operations. Therefore, even if combined, the combination of Fischer, Goodman, Menezes and Nakamura fails to teach at least using a secure encryption key in a first mode for encryption and test operations and using the secure encryption key in a second mode for time stamping operations. The Action fails to show how the combination of references teaches or suggests all of the claim limitations of claim 1.

Therefore, the Action does not establish a *prima facie* case of obviousness to reject claim 1 under 35 U.S.C. § 103(a) based on the combined teachings of Goodman, Fischer, Menezes and Nakamura.

Accordingly, claim 1 is allowable over the cited references and allowance thereof is respectfully requested. Claims 2-6 and 8-10, which depend from claim 1, are also in condition for allowance because of their dependence on an allowable claim.

Claim 11 is allowable for reasons analogous to those given for claim 1 and allowance thereof is respectfully requested. Claims 12-14, which depend from claim 11, are also in condition for allowance because of their dependence on an allowable claim.

Claim 15 is allowable for reasons analogous to those given for claim 1 and allowance thereof is respectfully requested. Claims 16-18, which depend from claim 15, are also in condition for allowance because of their dependence on an allowable claim.

Claim 20 is allowable for reasons analogous to those given for claim 1 and allowance thereof is respectfully requested. Claims 21-24, which depend from claim 20, are also in condition for allowance because of their dependence on an allowable claim.

Claim 25 is allowable for reasons analogous to those given for claim 1 and allowance thereof is respectfully requested.

Applicant requests reconsideration and withdrawal of the rejection of claims 1-6, 8-18 and 20-25 under 35 U.S.C. § 103(a) as being unpatentable over Goodman, Fischer, Menezes and Nakamura.

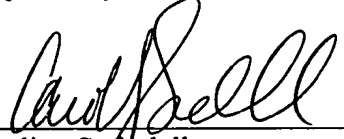
Conclusion

All of the stated grounds of rejection have been properly traversed. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

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Respectfully submitted,

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